

REMARKS

The Examiner has required restriction to one of the following groups:

Group I, claims 1-15 drawn to a rail fastener driver apparatus;

Group II, claim 16, drawn to a method of driving a rail fastener;

Group III, claim 17, drawn to a jaw mount;

Group IV, claims 18-20, drawn to a jaw block; and

Group V, claim 21, drawn to a jaw.

First of all, Applicants withdrew claim 16 in the Second Preliminary Amendment filed by facsimile on September 9, 2004. As such, the requirement for Group II is considered moot. The Examiner has based this requirement on the standard set out in MPEP § 806.05(c) relating to connected combinations and subcombinations. There is a two-part test, both parts must be satisfied to justify the restriction. The first part of the test is that the combination does not require the particulars of the subcombination. That leg is met here re claims 17, 18 and 21.

However, the second leg of the test is that the subcombination has utility by itself or in other combinations. As amended, claims 17, 18 and 21 have been amended to recite, among other things, that the respective claimed subcombinations are each for use with, and are structurally interrelated with the combination as recited in claim 1. All of the features of claim 1 are found in the preambles of claims 17, 18 and 21. Also, each of these claims have been amended to recite a structural interrelationship with the combination of claim 1. Further, the respective claims are also related to each other, in

that the jaws of claim 21 are part of the jaw block assembly of claim 18, which is connectable to the jaw mount of claim 17. Applicants submit that the only claimed utility of these subcombinations is in conjunction with the claimed combination as now recited. Accordingly, the second leg of the test in MPEP § 806.05(c) is not met, and the restriction requirement is respectfully traversed.

In addition, the Examiner has not established that a separate field of search would be required for the inventions of Groups I, III-V. Indeed, they are all classified in Class 104 as indicated by the Examiner. The Examiner has failed to make out a *prima facie* case that, if the inventions in Groups I, III-V were to be examined together, there would be a serious burden imposed upon the Examiner. See M.P.E.P § 803. In fact, the Examiner has failed to make any showing of such a burden.

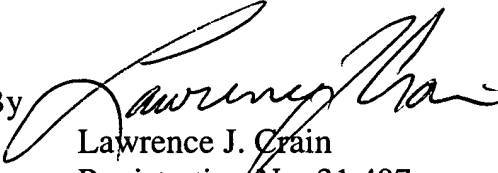
On the contrary, it appears as though no serious burden exists because, as amended, the same, or a very similar, search is required for a proper examination of all of the pending claims. Therefore, minimal, if any, additional searching would be required if all of the claims were examined together. Such a search would not pose a serious burden upon the Examiner.

Applicants respectfully submit that, in view of the amendments to the claims, the restriction requirement is improper and should be withdrawn. In the event the Examiner elects to continue the requirement, Applicants elect Group I, claims 1-15 with traverse.

In the event there are further issues prior to examination which may be addressed by telephone interview, the Examiner is urged to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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